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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1930

No. 3

POWERS-KENNEDY CONTRACTING CORPORATION and ANTHONY G. FLECK
Petitioners

against

CONCRETE MIXING AND CONVEYING COMPANY
Respondent

SUPPLEMENTAL BRIEF FOR PETITIONERS ON REARGUMENT

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IN THE

Supreme Court of the United States

POWERS-KENNEDY CONTRACTING CORPORATION and ANTHONY G. FLECK, *Defendants-Petitioners,* v. CONCRETE MIXING AND CONVEYING COMPANY, *Plaintiff-Respondent.*	No. 3 October Term, 1930. Formerly No. 501. October Term, 1928.

SUPPLEMENTAL BRIEF FOR PETITIONERS ON REARGUMENT.

This case, now No. 3 (which came here from the Second Circuit), and its companion case, now No. 4 (which came from the Ninth Circuit), were argued before this Court as one case, on April 16, 1929. At that time the present case was No. 501, and the companion case from the Ninth Circuit was No. 528. Subsequent to the argument on April 16, 1929, this Court ordered these two cases to be restored to the calendar for reargument, and they are now before the Court pursuant to said order.

This is a supplemental brief in behalf of the defendants-petitioners from the Second Circuit.

It is respectfully requested that our main brief filed prior to the original argument be given full consideration at this time, the present brief taking up only supplemental matters, chiefly those arising out of the former argument. Such matters, therefore, will be discussed under suitable captions without prefatory matter, which latter is deemed non-essential.

I.

Patentee's Contradictory and Untenable Position on Testimony as to Prior Uses.

The patentee (who is respondent from the Second Circuit and is petitioner from the Ninth Circuit) is in an absolutely contradictory and untenable legal position on the question of the prior use testimony presented in the two records from the Second and Ninth Circuits, respectively. *The prior uses in evidence in the two records are entirely independent of each other, and relate to entirely different occurrences, persons and dates.*

Patentee is insisting here that, under the decisions of this Court, the findings of fact of the Second Circuit tribunals on that prior use testimony (which was favorable to the patent) be considered as "conclusive" and "unassailable," but patentee insists equally emphatically that the concurrent findings of fact of the Ninth Circuit tribunals, *which held the patent to be invalid because of prior use*, be considered *de novo* and reversed by this Court.

The only reason (so far as we can gather) for demanding this discriminatory treatment (*i. e.*, asking this Court to apply the law to the Second Circuit record, and to disregard it as to the Ninth Circuit record), is that the findings of fact on prior use in the Second Circuit record are favorable to the patent, and the concurrent findings of fact on the entirely different prior use by the Ninth Circuit tribunals are fatal to the patent. If there is any other "reason" why this rule of law should not be applied to the Ninth Circuit testimony, we are waiting to be enlightened.

To consider the entire matter more in detail:

I-a.

Concurrent Findings of Fact of Lower Courts are "Conclusive" and "Unassailable."

In patentee's brief as respondent from the Second Circuit, filed previous to the former argument, it is urged as to the Second Circuit prior use evidence (at p. 116 of the brief:

> "But the trial court, after hearing all the witnesses in open court, found that no prior use was shown (Opinion, R. 327), and that finding of fact is *conclusive*. *Adamson* v. *Gilliland*, 242 U. S. 350; 37 Sup. Ct. Rep. 169."

Again at pages 124 and 125 of its said brief, the patentee urges:

> "In *Adamson* v. *Gilliland*, 242 U. S. 350, 37 Sup. Ct. Rep. 169, 61 L. Ed. 356, this Court passed upon a situation very similar to the present one and said:
>
> "'Considering that a patent has been granted to the plaintiff, the case is pre-eminently one for the application of the practical rule that so far as the finding of the master or judge who saw the witnesses *"depends upon conflicting testimony or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable."*' Davis *v.* Schwartz, 155 U. S. 631, 636, 39 L. Ed. 289, 291, 15 Sup. Ct. Rep. 237."

If this rule of law, laid down by this Court, that the concurrent findings of fact of the lower tribunals are "conclusive" (Adamson *v.* Gilliland, *supra*) and "unassailable" (Davis *v.* Schwartz, *supra*) governs in the Second Circuit, as so earnestly argued by the patentee, *it governs equally in the Ninth Circuit* where the findings of fact on prior use are fatal to the patent.

The findings of fact in the Ninth Circuit as to invalidity of the patent because of prior use, are as follows:

Judge BOURQUIN, the trial judge (R. Case No. 4, p. 619), held:

> "* * * but as between them, in its present aspect in McMichael it is the idea and method of Leake and not McMichael, in that prior to McMichael, Leake had conceived the idea *and in 1905 in New Orleans had publicly and successfully employed it in concrete building operations.*
>
> "For despite Leake's reluctance to testify against his assignee, the plaintiff, *the evidence in quality and quantity inspires confidence and constrains conviction of the truth of the fact and beyond reasonable doubt.*
>
> "Neither of them, however, is inventor of the thing. Before them, it was old in the art."

That is, it was old in *Smith*, 122, 498; *Canniff*, 873, 345; and *McIlvrid*, 958, 421 (R. 616; 23 F. [2] 133).

The Court of Appeals of the Ninth Circuit held (R. Case No. 4, pp. 670-673):

> "It is assigned as error that the trial court found that Leake had made the invention in issue prior to the date of McMichael's application. In the opinion of the trial court it is said, 'Prior to McMichael, Leake had conceived the idea and in *1905 in New Orleans had publicly and successfully employed it in concrete building operations,* for despite Leake's reluctance to testify against his assignee, the plaintiff, the evidence, in quality and quantity, inspires confidence and constrains conviction of the truth of the fact, and beyond reasonable doubt.'
>
> * * * * * * *
>
> "As a witness for the appellee in the court below, Leake testified that he conceived the idea of moving concrete, as set forth in his application, about February 1, 1905, that he made a container in which

> to put the concrete and by the means of an air pipe extending therefrom shot it up on top of a power-house then being constructed in New Orleans, that *when the air pressure was applied, the concrete all went up and landed on there*, that later he built a commercial apparatus in Chicago and operated it in conveying dry cinders to the fifth floor of a building. *His testimony, together with his preliminary statement, carried the date of his invention back of that of McMichael and showed an actual reduction to practice by Leake as early as 1905. We find no ground for disturbing the trial court's conclusion.*"

This was not a perfunctory affirmation by the Appellate Court of the finding of fact by the District Judge "who saw and heard the witnesses." The correctness of that finding by the District Court was taken up on a specific assignment of error, and the opinion of the Circuit Court of Appeals intrinsically evidences a thorough reconsideration of the entire record as bearing on the prior use testimony. In support of this, we quote, immediately following, rather fully from the appellate opinion.

To aid in getting the full import of this exceedingly concise, comprehensive and well-considered passage, we have broken it into additional paragraphs and have interpolated sub-heads, and some comment, *but have copied the text of the opinion verbatim*, as follows:

> "It is assigned as error that the trial court found that Leake had made the invention in issue prior to the date of McMichael's application. In the opinion of the trial court it is said, 'Prior to McMichael, Leake had conceived the idea and in *1905 in New Orleans* had publicly and successfully employed it in concrete building operations, *for despite Leake's reluctance to testify against his assignee, the plaintiff, the evidence, in quality and*

> *quantity, inspires confidence and constrains conviction of the truth of the fact, and beyond reasonable doubt.'"*

Leake's application disclosed the "invention" fully *before he ever knew of McMichael*:

> "The McMichael application was filed January 14, 1907, and *nine months later on October 7, 1907, was filed Leake's application,* which presents everything contained in the McMichael application with the exception of the U-bend. Leake said, 'The object of my invention is to provide a method and apparatus for preparing a concrete mixture and delivering it while in a plastic condition to the place where it is to be utilized. Another object of my invention is to move plastic concrete from one place to another by means of air pressure.'"

DECLARATION OF THE INTERFERENCE BY THE PATENT OFFICE:

> "On May 12, 1909, interference was declared between McMichael and Leake and Wm. W. Darley, who had applied for a patent on 'apparatus for handling ashes and other materials.' Leake and Darley each filed an affidavit setting forth their respective dates of conception and reduction to practice. Darley was dismissed from the interference as being found subsequent in time to the others."

Leake, in his preliminary statement, *before he had access to McMichael's application, or had knowledge of his dates,* made oath that he had *successfully practiced the invention in New Orleans in 1905*:

> "Leake's affidavit stated that he 'conceived the invention set forth in the declaration of interference on or about the 1st day of February, 1905, that he first made drawings of the invention on or about the 1st day of March, 1905, and first explained the invention to others on or about the 1st day of

> June, 1905, that he first embodied his invention in a full-sized machine which was completed on or about the 1st day of September, 1905, and that *on or about the 1st day of September, 1905, the said machine was first successfully operated in the City of New Orleans, and State of Louisiana*, and that he has since made and used other machines embodying the same invention.' Before the interference was declared it was represented on behalf of Leake's application that he had done a large amount of experimental work in connection with his invention. '*He has successfully moved concrete from the place where it is mixed to the place where it is to be used, by means of air pressure, using the apparatus disclosed in his application.*' Again it was said, 'He has given considerable time and thought to this matter and has actually constructed several plants where this is done. Their operation is highly successful and appears to be a decided improvement over previously known methods for handling plastic concrete.' "

In the interference, McMichael could have relatively easily and inexpensively taken testimony and proved priority, *were he indeed the prior inventor.* Instead of doing so, he paid Leake $6,000 for a paper "concession of priority":

> "The long period of inaction and silence on the part of McMichael, unexplained as it is, together with the payment to Leake *of so large a sum of money as $6,000* payable as it was in annual installments until March 1, 1920, is *strongly suggestive of the inference that McMichael recognized the priority of Leake's invention and could furnish no proof to the contrary.*"

The significance of this course of action is well stated by the Appellate Court as follows:

> "*But no showing was made or evidence offered to carry the McMichael invention farther back than the date of his application,* nor was any proceeding had in the Patent Office upon his application until 19 months thereafter when for a *consideration of $6,000 Leake assigned his application to McMichael's attorney,* who later assigned it to the appellant which had become also the owner of the McMichael application."

Prior inventors are not in the habit of *giving* $6,000 to *later* inventors.

Leake's testimony in this case *is in harmony with the entire record proceedings in the interference.* The appellate court justly attached great significance to the entire agreement of the statements in Leake's preliminary statement filed in 1909, before he saw McMichael's application, with the reluctant testimony which he gave for the defendant. On this point, the decision states:

> "As a witness for the appellee in the court below, Leake testified that he conceived the idea of moving concrete, as set forth in his application, about February 1, 1905, that he made a container in which to put the concrete and by the means of an air pipe extending therefrom shot it up on top of a power-house then being constructed in New Orleans, that *when the air pressure was applied, the concrete all went up and landed on there,* that later he built a commercial apparatus in Chicago and operated it in conveying dry cinders to the fifth floor of a building. *His testimony, together with his preliminary statement, carried the date of his invention back of that of McMichael and showed an actual reduction to practice by Leake as early as 1905. We find no ground for disturbing the trial court's conclusion.*"

It is of basic significance in this Ninth Circuit record (1) *that the testimony is entirely uncontradicted;* (2) is

in full accord with all the record evidence; and (3) *the Appellate Court upheld the Trial Judge on these findings in every respect.*

The various matters of record evidence referred to in the appellate opinion, just quoted and discussed, are identified under the following caption:

I-b.

Evidence on Which Trial Court and Court of Appeals of the Ninth Circuit Based Their Findings of Fact.

The evidence in the Record in Case No. 4 (formerly No. 528) on which the courts based their decision is as follows:

1. Testimony of Thomas Leake, Record, pages 578-608, inclusive:

   (A) His testimony that he had received $6,000 from the respondent for his application.

   (B) This evidence was not rebutted in any way.

   (C) He was a hostile witness.

2. File wrapper and contents of the Leake application (Books of Exhibits, pp. 333-453, inclusive).

3. Leake's patent No. 1,215,558 (Book of Exhibits, pp. 454-462).

4. Assignment by Leake to plaintiff's attorney for $6,000 (Book of Exhibits, pp. 469-479).

5. Leake's sketch Exhibit No. 127 (Book of Exhibits, p. 694).

I-c.

Authorities on This Point.

This doctrine as to the "conclusiveness" and "unassailability" of concurrent findings of fact has been repeatedly laid down by this Court over a very long period of years, and a few of the decisions will be briefly excerpted here.

In *Metsker* v. *Bonebrake*, 108 U. S. 66, 2 Sup. Ct. Rep. 351, 354, the Court held:

> "*The findings of the master are prima facie correct.* Only such matters of law and of facts as are brought before the Court by exceptions are to be considered, and the burden of sustaining the exception is on the objecting party. In the case before us we are inclined, after a careful examination of the testimony, to concur with the master's report. It is altogether a matter of the weight of evidence."

In *Tilghman* v. *Proctor*, 125 U. S. 136, 149, where the Court held:

> "We are then brought to a consideration of the exceptions taken to the master's report in matters of fact, affecting the accuracy of his conclusions in respect to the amount of those profits, gains and savings. In dealing with these exceptions, the conclusions of the master, depending upon the weighing of conflicting testimony, have every reasonable presumption in their favor, and are not to be set aside or modified unless there clearly appears to have been error or mistake on his part. Metsker *v.* Bonebrake, 108 U. S. 66; Donnell *v.* Columbian Ins. Co., 2 Sumner, 366, 371; Mason *v.* Crosby, 3 Woodb. & Min. 258, 269; Paddock *v.* Commercial Ins. Co., 104 Mass. 521, 531; Richards *v.* Todd, 127 Mass. 167, 172."

In *Kimberly* v. *Arms*, 129 U. S. 512, 9 Sup. Ct. Rep. 355, 360, the Court held:

> "We are therefore constrained to hold that the learned Court below failed to give to the findings of the master the weight to which they were entitled, and that they should have been treated as so far correct and binding as not to be disturbed unless clearly in conflict with the weight of the evidence upon which they were made."

In *Davis* v. *Schwartz*, 156 U. S. 631, 15 Sup. Ct. Rep. 237 (referred to and followed in *Adamson* v. *Gilliland*), the Court held:

> "1. As the case was referred by the court to a master to report, not the evidence merely, but the facts of the case, and his conclusions of law thereon, we think that his finding, so far as it involves questions of fact, is attended by a presumption of correctness similar to that in the case of a finding by a referee, the special verdict of a jury, the findings of a circuit court in a case tried by the court under Revised Statutes, Sec. 649, or in an admiralty cause appealed to this court. In neither of these cases is the finding absolutely conclusive, as if there be no testimony tending to support it; *but so far as it depends upon conflicting testimony, or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable.* Wiscart *v.* Dauchy, 3 Dall. 321; Bond *v.* Brown, 12 How. 254; Graham *v.* Bayne, 18 How. 60, 62; Norris *v.* Jackson, 9 Wall. 125; Insurance Co. *v.* Folsom, 18 Wall. 237, 249; The Abbotsford, 98 U. S. 440."

In *Adamson* v. *Gilliland*, 242 U. S. 350, 37 Sup. Ct. Rep. 169, 171, the Court held:

> "' • • • the case is pre-eminently one for the application of the practical rule that so far as the finding of the master or judge who saw the witnesses 'depends upon conflicting testimony or upon the credibility of witnesses, or so far as there is any

> testimony consistent with the finding, it must be treated as unassailable.' Davis *v.* Schwartz, 155 U. S. 631, 636, 39 L. Ed. 289, 291, 15 Sup. Ct. Rep. 237."

In *United States* v. *United Shoe Machinery Co.*, 247 U. S. 32, 38 Sup. Ct. Rep. 473, 475, a case in which there was a sharp conflict on the fact testimony (while in the present case the testimony is unrebutted) this Court held:

> "The contentions could not well be more antagonistic, upon each of which there was conflicting testimony and the important fact is to be borne in mind that it was given in open court (except as to certain contentions about patents, their scope and validity). The fact justifies deference to the findings of the trial court. Adamson *v.* Gilliland, 242 U. S. 350, 353, 37 Sup. Ct. Rep. 169, 61 L. Ed. 359."

In *Mason* v. *United States*, 260 U. S. 545, 43 Sup. Ct. Rep. 200, the Court held:

> "The Circuit Court of Appeals suggested doubts respecting the honesty of defendants' motives in seeking or in acting upon advice of counsel; but we cannot ignore the finding of the master explicitly to the effect that the locators proceeded in 'moral good faith.' *His finding was made after hearing and seeing the witnesses and, having support in the evidence, will be accepted here.* See Adamson *v.* Gilliland, 242 U. S. 350, 353, 37 Sup. Ct. Rep. 169, 61 L. Ed. 356."

We agree with opposing counsel as to what the law is, but insist that this rule be applied to *all* the findings of fact *in both records.*

If that is done, and we submit it must be done, on the authority of this Court over a period of fifty years, then the consideration of any other questions presented in the record is unnecessary. The patent in suit is invalid.

I-d.

Patentee's False Contention that Leake's Device Was An Abandoned Experiment.

The record is entirely against this contention of patentee. What the record actually shows is:

In 1905 Leake successfully reduced his invention to practice by pneumatically conveying concrete at New Orleans.

In October, 1907, Leake filed his application, covering not only his pneumatic concrete conveyor, which he successfully used in 1905, but also a very complete mixer coacting with the conveyor.

Between October, 1907, the date of filing of Leake's application, and May 18, 1909, when the interference with McMichael was declared, a period of about twenty months, Leake filed seven amendments and arguments in the Patent Office in seeking allowance of his application (9th Cir. R. 355-402, 463).

In May, 1909, he accepted the interference with McMichael's application, and continued to fight until McMichael paid him $6,000 for a concession of priority and an assignment of the application.

As we read this record it establishes continuous progressive activity, and unusual diligence, up to the very time when McMichael paid Leake the $6,000 for the assignment of his application and the paper "concession of priority."

Leake is far within the law on this subject, laid down in the following authorities:

In *Brush* v. *Condit*, 132 U. S. 39, 48, 49, this Court held:

> "'The case is that of the public, well-known, practical use in ordinary work, with as much success as was reasonable to expect at that stage in the development of the mechanism belonging to electric arc lighting, of the exact invention which

was subsequently made by the patentee; and, although only one clamp and one lamp were ever made, which were used together two and one-half months only, and the invention was then taken from the lamp and was not afterwards used with carbon pencils, it was an anticipation of the patented device, under the established rules upon the subject. With a strong disinclination to permit the remains of old experiments to destroy the pecuniary value of a patent for a useful and successful invention, and remembering that the defendants must assume a weighty burden of proof, I am of the opinion that the patentee's invention has been clearly proved to have been anticipated by that of Hayes. *Coffin* v. *Ogden*, 18 Wall. 120; *Reed* v. *Cutter*, 1 Story, 590; *Pickering* v. *McCullough*, 104 U. S. 310; Curtis on Patents, Secs. 89-92.

" 'The bill, so far as it relates to the clamp patent, is dismissed.'

"We have examined carefully the evidence in this case, relied upon by the plaintiffs to show that the clamp arrangement of Hayes was not a perfected invention, but was merely an abandoned experiment, and we have arrived at the conclusion that Judge SHIPMAN's views on the subject are correct. They are well and accurately expressed, and we could not add to their force by a prolonged discussion of what is purely a question of fact."

In *Gayler* v. *Wilder*, 10 How. 477, 498, the Court held:

"We do not understand the Circuit Court to have said that the omission of Conner to try the value of his safe by proper tests would deprive it of its priority; nor his omission to bring it into public use. He might have omitted both, and also abandoned its use, and been ignorant of the extent of its value; yet, if it was the same with Fitzgerald's, the latter would not upon such grounds be entitled to a patent, provided Conner's safe and its mode of construction were still in the memory of Conner before they were recalled by Fitzgerald's patent."

II.

McMichael Merely a Minor Improver in Art of Pneumatically Conveying Concrete.

The present is a typical case of a minor improvement patent being pushed, by most strenuous efforts of counsel, to appear as a pioneer patent.

Judge BOURQUIN, in his decision, 23 Fed. (2) 131, 133; R. p. 616, held on this point:

> "*Moreover, prior to McMichael were patents for appliances and methods to convey concrete by the agency of compressed air.* Amongst these are Smith, 122,498 of 1872, Cannif, 873,345 of 1906, and McIlvrid, 958,421 of 1905. In so far as it is argued that some of these are for grout, and will not function with less liquid concrete, the answer is they can be used for any practical flowable concrete, and they have been. They are of the simplicity of McMichael's, and even average intelligence will perceive their ability to operate successfully."

The Ninth Circuit Court of Appeals, in its decision, 27 Fed. (2) 838; R. pp. 668, 669 held:

> "Of the prior patents we find it necessary to refer particularly to but three, the *patent to Smith, No. 122,498*, of January 2, 1872, and the English patents to Duckham, one No. 4,400 of 1875, and one No. 15,348 of 1885. The Smith patent was for 'An improvement in the manufacture of concrete pavements and machinery for same.' The specifications described the apparatus as specially adapted to the manufacture and convection of *concrete* composition through pipes so as to set quickly upon reaching its destination and form a solid mass of artificial stone, *and uncontradicted testimony was given of the successful use of the Smith machine in conveying concrete through a*

> *pipe by compressed air.* The device contained all the features of the appellant's patent except the nozzle for admission of air near the point of exit."

We believe that no further argument is needed on the point that McMichael's was not a pioneer patent in pneumatically conveying concrete. This concurrent finding of the lower courts should be treated as "conclusive" (*Adamson* v. *Gilliland, supra*) and as "unassailable" (*Davis* v. *Schwartz, supra*).

Not only do the patents to Smith, No. 122,498; Cannif, No. 873,345; and McIlvrid, No. 958,421, disclose devices for pneumatically conveying concrete, *but they also clearly teach that practically any of the pneumatic conveying devices of the art can be used for pneumatically conveying or "blowing" practically any plastic, granular, particulate, or other fluent materials.* Smith patents 122,497 and 122,498 clearly disclose the use in such machines of *the modern liquid or fluent concrete.* The arrangement of the metal chamber, the curved delivery pipe, and *either* one or two air-blowing pipes, and the application of air both above and below, or either above or below the concrete or other material to be conveyed is old in numerous prior patents as pointed out in our main brief.

II-a.

Patentee's Contention that Smith Patent 122,498 is Inoperative Totally Conflicts With Record.

The patentee persists in the unfounded contention that this patent is inoperative. This contention is but an index of the recognition of the deadly character of this Smith patent No. 122,498 as anticipating and invalidating the patent in suit.

The utility (*i. e.*, operativeness) of every patent is presumed unless it is overcome by evidence.

In *Gandy* v. *Main Co.*, 143 U. S. 587, 595, the Court said:

> "The language of Mr. Justice Woods in delivering the opinion in *Lehnbeuter* v. *Holthaus*, 105 U. S. 94, 96, is equally pertinent to this branch of this case: 'The patent is *prima facie* evidence both of novelty and utility, and neither of these presumptions has been rebutted by the evidence. On the contrary, they are strengthened.'"

In *Dashiel* v. *Grosvenor*, 162 U. S. 425, 432, the Court said:

> "The very fact that a machine is patented, is some evidence of its operativeness, as well as of its utility, * * *"

In *Pickering* v. *McCullough*, 104 U. S. 310, 319, the Court held:

> "It is objected, however, that the machines described in these patents are mere paper machines, not capable of successful practical working. But on examination it sufficiently appears, we think, that the objections can be sustained only as to minor matters of detail in construction, not affecting the substance of the invention claimed, and could be removed by mere mechanical skill, without the exercise of the faculty of invention. In this view, the Wise and Smith patents are not rendered inefficient as defenses in this suit, by reason of the alleged imperfections of the machines described in them."

There was no testimony whatever offered even tending to show that the Smith patent 122,498 is in anywise inoperative.

Notwithstanding that there was no obligation on the Ninth Circuit defendant to do so, tests were made and testimony taken to prove the operativeness of the Smith patent.

II-a-1.

Successful Operation of Smith Device.

In its Second Circuit brief, at page 106, patentee contends:

> "8. The courts in the Ninth Circuit also erred in considering the test made *in camera* by the defendants of the alleged Smith 1872 apparatus, of importance, for the following reasons, among others:
>
> a. The test was made without the presence of anyone representing the plaintiff."

And much more to the same effect.

In reply to this we submit:

1. No objection was made at the trial to the testimony of Hackley (R. 429-431) or Wilkins (R. 447-453) that the Smith machine was operated successfully, nor to the admission in evidence of the replica of the machine of the Smith patent, which was successfully operated (Exhibit 185).

2. No assignment of error was based on the admission of the evidence of successful operation of Smith's machine, nor of the machine itself as Exhibit 185. See *Wood* v. *Wilbert*, 226 U. S. 384; *Camden* v. *Stuart*, 144 U. S. 104.

3. The record shows (R. 61-63) that patentee's counsel acknowledged notice given them by defendant's counsel of the making of the tests with the Smith machine and the invitation to be present at those tests.

4. No attempt was made by patentee to rebut the very conclusive evidence of the successful operation of the machine of the Smith patent.

It is too late for patentee in its brief before this Court to initially assail the admissibility of the evidence of the successful operation of the Smith machine.

II-a-2.

The findings of fact of the Ninth Circuit tribunals on the testimony concerning the successful operation of the Smith machine are as follows:

Judge BOURQUIN held (23 Fed. [2] 133) concerning the Smith and other patents:

> "They are of the simplicity of McMichael's, *and even average intelligence will perceive their ability to operate successfully.*"

The Court of Appeals (27 F. [2] 839) held:

> "The Smith patent was for 'An Improvement in the manufacture of concrete pavements and machinery for same.' The specifications described the apparatus as specially adapted to the manufacture and convection of *concrete* composition through pipes so as to set quickly upon reaching its destination and form a solid mass of artificial stone, *and uncontradicted testimony was given of the successful use* of the *Smith machine in conveying concrete through a pipe by compressed air.* The device contained all the features of the appellant's patent except the nozzle for admission of air near the point of exit."

These findings of fact as to the operativeness of the Smith patent in pneumatically conveying concrete should be regarded as "conclusive" and "unassailable" (*Adamson* v. *Gilliland*, and *Davis* v. *Schwartz*, *supra*).

In *Coffin* v. *Ogden*, 18 Wallace 120, 124, the Court held:

> "The invention or discovery relied upon as a defense, must have been complete, and capable of

producing the result sought to be accomplished; and this must be shown by the defendant. * * * *The prior knowledge and use by a single person is sufficient. The number is immaterial.*"

III.

McMichael Patent "A Nose of Wax."

"Some persons seem to suppose that a claim in a patent is like a nose of wax, which may be twisted and turned in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express." *White* v. *Dunbar,* 119 U. S. 47; 7 S. Ct. Rep. 72, 74.

The McMichael "nose of wax" has been twisted in several directions. This twisting was in four stages, which will now be described.

Stage No. 1. The Alleged Invention of the McMichael Application as Filed in 1907.

The preamble to McMichael's application *as filed* stated:

"This invention relates to apparatus for elevating and transporting *granular and plastice material,* such as *sand, plaster, mortar and concrete*" (9th Cir. R. pp. 196, 197).

The significance of this statement lies in the truthful statement that the McMichael tank and pipes would pneumatically convey *either* granular material such as *sand,* or plastic material such as *mortar* or *concrete.*

The corollary of this is, that the prior patents (probably unknown to McMichael at that time) for pneumatically conveying granular material, and having almost identically the same structure, become admittedly anticipating prior art.

Statements of Patentee's Chief Engineer, Kirkland.

Kirkland, after six years, as chief engineer for the patentee, in supervising the installation of the McMichael devices and giving instruction in the use of them (2nd Cir. R. 104-112), in his address to the Western Society of Engineers stated (R. 108):

> "* * * these portions are *carried along in suspension much as dust is carried along in a storm,* * * * the air velocity in passing through the pipe is *sufficient to keep the materials in suspension,* and it is *important to have a sufficient air pressure to keep the materials in suspension,* * * *."

In that same address, Kirkland stated that he had actually used the McMichael patent device on the same day to pneumatically convey or "blow" concrete, a *plastic* material, and also a mixture of limestone screenings and sand, a *granular* material (Exhibit H, pp. 334-5), as follows:

> "The packing material consisted of a mixture of 75 per cent. limestone screenings and 25 per cent. sand. This was blown in, filling the cavity completely, and packing it tightly."

The purport of the foregoing is that Kirkland, patentee's chief engineer, in 1918 (before there was any litigation or any necessity to "put over" the patent), told the Western Society of Engineers that the McMichael device operates (1) upon either plastic *or* granular materials, exactly as stated in the specification *as filed* in 1907, and (2) exactly as do all the devices of the prior art which have the material containing chamber, the delivery pipe, and either one or two compressed air pipes, that is, it simply blows the material through the pipe. It is in effect a statement that the device does not operate on the "slug theory" (introduced illegally into the specification

in 1911) and which Judge BOURQUIN stated did "violence to the laws of nature and confounded reason."

The sum total of the foregoing was, in effect, the admission of the fact that McMichael in structure and method is identical with the prior art.

Under stress of litigation, Kirkland attempted to repudiate some of his statements to the Western Society of Engineers (2nd Cir. R. 103-110).

Stage No. 2. McMichael Specification Transformed in Patent Office.

In 1911 and 1913 (four and six years after filing) after all the claims had been repeatedly rejected on the prior patents above referred to, *and after access was had to the Leake specification*, the McMichael specification was rewritten as "a METHOD OF and an apparatus for transporting AND TREATING CONCRETE" (9th Cir. R. 197; 217-220; 224, *et seq.*).

This transformation involved the illegal insertion of new matter, thereby rendering the patent invalid. *Railway Co.* v. *Sayles*, 97 U. S. 554; *Michigan Central R. R.* v. *Consolidated Co.*, 67 Fed. 121. This matter is treated fully in our main brief.

Stage No. 3. The "Slug" Theory.

The slug theory made its appearance in the first litigation, as the third stage of twisting "the nose of wax," and it was persisted in until judicial decisions compelled its abandonment.

It first appeared in the testimony in the "Ulen suit" of Ray, the patent expert, and the concurring testimony of Kirkland, the chief engineer (the latter's testimony being in flat contradiction to his statement to the Western Society of Engineers).

The theory is discussed in our main brief.

The position of the patentee up to the time of the decision of Judge BOURQUIN, in the District Court at Seattle, is expressed in their brief (p. 4) before the Court of Appeals of the Second Circuit, as follows:

> "The operation of an apparatus made according to the patent and operated according to the method therein defined *produces the peculiar result of first pressing the concrete mass into the outlet and packing it there, then cutting off successive sub-masses or slugs at the outlet, and then propelling these masses or 'slugs' in quick succession through the delivery pipe to the distant point of placement.*"

Stage No. 4. The "Slug" Theory is Abandoned, and the "Velocity Nozzle" Theory is Substituted Before This Court.

This final twist in "the nose of wax" was caused by

(1) the decision of Judge BOURQUIN that the slug theory "would do violence to the laws of nature and confound reason. It cannot be done."

(2) the decision of the Ninth Circuit Court of Appeals (9th Cir. R. p. 675) that the slug theory was impossible and furthermore that it was not in McMichael's original application but years later was imported as illegal new matter from Leake's application.

(3) The Court of Appeals of the Second Circuit (2d Cir. R. p. 346) held:

> "Such statements necessarily forbid the notion of solid slugs."

IV.

Patentee Relies in This Court on a New Theory—the "Velocity-Nozzle."

In patentee's brief here from the Second Circuit (p. 97) the slug theory is expressly abandoned as a basis for attempting to hold alleged infringers.

Consequent upon the decisions of the several courts condemning the "slug" theory, the patentee has shifted position completely, and before this Court, asserts that the essential feature of the McMichael patent is the "velocity nozzle." See pages 75, *et seq.*, of patentee's Ninth Circuit brief. This new "velocity nozzle" theory is a total departure from the previous "slug theory." So long as the latter theory prospered in the courts, it was McMichael's invention. Now that it has been discredited and condemned by the Courts, it has been discarded by patentee (Patentee's 2d Circuit Brief, p. 97), and lo, the McMichael invention is the "velocity nozzle."

To realize the extent of this last twist to the McMichael "nose of wax," let us compare, in parallel, their contention here with their contention before the Second Circuit Court of Appeals.

Patentee's Brief (p. 4) 2d C. C. A.:

"The *operation of an apparatus made according to the patent and operated according to the method* therein defined produces the peculiar result of *first* pressing the concrete mass into the outlet and packing it there, *then cutting off successive sub-masses or slugs at the outlet*, and then

Patentee's Briefs in this Court:

(2d Circuit Brief, p. 97):

"Nor has the respondent ever contended that the slug method of operation was essential to infringement."

(9th Circuit Brief, p. 75):

"* * * the devices which were held to infringe in the *Ulen* and *Powers-Kennedy*

propelling these masses or 'slugs' in quick succession through the delivery pipe to the distant point of placement."

cases, employs a *velocity nozzle* * * *. Each would fail as a concrete placer if it were stripped of its velocity nozzle."

(After patentee's brief for the 2d Circuit Court of Appeals, just quoted from, was written, Judge BOURQUIN ruled that the "slug" theory "did violence to the laws of nature and confounded reason," and the two Circuit Courts of Appeals also condemned it.)

In *White* v. *Dunbar, supra*, this Court condemned this procedure, as follows:

> "The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; *and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms.*"

This is a flagrant case of the wax nose twisting totally condemned by this Court. *There is no more occasion for an honest patent to skulk, dodge or evade than there is for an honest man to do so.* Attempts to totally change the basic purport of a patent, as has been done by McMichael, are as unethical as changing boundary maps or moving monuments.

V.

Falsity of "Velocity Nozzle" Theory Proved by the Record.

Facing page 76 of patentee's Ninth Circuit brief is a diagram showing several pneumatic concrete conveying machines, and on page 76 is stated:

> "The devices shown in the lower row cannot successfully be used for placing concrete. Why? One sufficient reason why they cannot be so used, is because each and every of these prior art devices is without a velocity nozzle."

Among the alleged inoperative devices in the lower row in said diagram are those of Smith patent, 122,498; Canniff patent 873,345, Duckham British patents 4,400 of 1875 and 15,348 of 1885, and Kolsche German patent 18,394 of 1881.

Patentee's brief asserts, absolutely contrary to the record and decisions, that all these are inoperative. Let us see what the record and the decisions in this case say as to the operativeness of these devices:

Judge BOURQUIN held (R. 616):

> "Moreover, prior to McMichael were patents for appliances and methods to convey concrete by the agency of compressed air. Amongst these are Smith 122,498 of 1872, Cannif, 873,345 of 1906, and McIlvrid, 958,421 of 1905. In so far as it is argued that some of these are for grout, and will not function with less liquid concrete, the answer is they can be used for any practical flowable concrete, and they have been. They are of the simplicity of McMichael's, and even average intelligence will perceive their ability to operate successfully.
>
> "The variety of concrete is not material, save in respect to the mere incidentals of pressure and size of container, load, and discharge conduit. In any apparatus, including McMichael, the concrete must be flowable in quality, and the pressure in due proportion to the weight and friction of the load ahead of it. To suit these incidentals to circumstances is mechanical, and not invention."

The 9th C. C. A. held:

> "Of the prior patents we find it necessary to refer particularly to but three, the patent to Smith, No. 122,498, of January 2, 1872, and the English patents to Duckham, one No. 4,400 of 1875, and one No. 15,348 of 1885. The Smith patent was for 'an improvement in the manufacture of concrete pavements and machinery for same.' The specifications described the apparatus as specially adapted to the manufacture and convection of concrete composition through pipes so as to set quickly upon reaching its destination and form a solid mass of artificial stone, *and uncontradicted testimony was given of the successful use of the Smith machine in conveying concrete through a pipe by compressed air.* The device *contained all the features* of the appellant's patent except the nozzle for admission of air near the point of exit."

The uncontradicted testimony as to the actual operativeness of the Smith and Canniff devices is in the 9th Circuit record, and has been referred to elsewhere.

The evidence in the record establishing clearly that Smith 122,498, Canniff No. 873,345, and McIlvrid 958,421, have successfully conveyed concrete pneumatically, and the concurrent findings of fact of the Ninth Circuit courts to that effect, are conclusive proof that patentee's newfound contention that a velocity nozzle is necessary is absolutely without foundation. But were that contention true, McMichael did not invent the velocity nozzle for pneumatically conveying various materials. It is very old and widely used in the prior art.

VI.

"Velocity Nozzle" an Ancient and Common Device in Pneumatic Conveying.

Nothing is more common in the art of pneumatic conveying than a "velocity nozzle." The use of a nozzle of this kind to speed the passage of any material through a pipe will be absolutely obvious to every mechanical man. They have been in common use in the art of pneumatic conveyance of material through pipes for a half century. Their name is legion in patents relating to pneumatic conveying. Taking only the patents at hand in the present record, attention is called briefly to the following (italics ours):

No. 707,840 to Goldie (9th Cir. R. 513; Ulen R. "Exhibit D," p. 335; and in the back of our main brief). At page 516, this patent states:

> "The injector pipe or hose 13 has a bend or elbow 21 just below the funnel 16, and the *steam pipe 17 projects into the ejector pipe or hose 13* at this bend and has its end lying below the opening from the funnel 16, *so that the steam will act on the principle of an ordinary injector and draw the cement out of the funnel 16 and force it through the hose or pipe 13* down underneath the tie."

No. 408,201 to Wallace (2nd Cir. R. 309). The patent states at page 310:

> "The operation is as follows: When the valve H in the pipe G is open, steam is admitted from the boiler to the coil F in the furnace E, is superheated in the same to the required degree, and then passes through the pipe C into the discharge pipe A. *The velocity of the steam escaping from the nozzle C' creates a vacuum* in the discharge pipe A between the nozzle end and the closed end B."

No. 267,318 to Beach (2nd Cir. R. 305). This patent states (p. 306):

> "M is a discharge pipe leading to a helper, by means of which 'helper', so-called, a new impetus is given to the article or commodity to be transported."

Claim 6 of this patent (p. 308) reads:

> "The combination of the receivers K, K with the *discharge pipe M* and switch N, *discharging into the pipe G' into a current of air moving with great velocity through the pipe G'* from the point of ingress (for said air) and the reservoir A, the *renewing of the momentum first imparted by means of the helper or pipe G' through which a current of air is impelled at great velocity.*"

No. 609,744 to Hennig (9th Cir. R. 675). This patent states (p. 678):

> "Where the fuel feed is periodically interrupted, *I prefer to supplement the action of the pressure behind the fuel by a stream of air, steam, or gas, so directed as to cooperate by induction to drive the fuel through the delivery pipe* in the manner shown in the drawings."

In Fig. 5 of the drawings the nozzle 6^a is shown acting as a velocity nozzle of blowing steam through the pipe 2 to give an added velocity to the fuel.

No. 730,884 to Davis (Ulen R. p. 339). This patent states (p. 342):

> "According to my invention improved means are provided for leading the fluid under pressure to the nozzle *k*, as shown, the nozzle being provided with a plurality of lateral apertures for the entrance of the fluid under pressure, it being understood, however, that but one lateral aperture may be used, if

desired, without departing from the spirit of my invention, since, as will be hereinafter seen, the principle of operation is the same in any case. Preferably the lateral apertures are arranged in the bottom *w* of the nozzle and extend transversely across the nozzle and are so arranged that entering fluid under pressure will be directed toward the mouth of the nozzle.

. . . . . .

"The fuel, as shown, descends from the hopper into the nozzle from above, while according to the arrangement of apertures *x the fluid under pressure is forced through the bottom of the nozzle* beneath the entering fluid and toward the mouth of the nozzle, *whereby the fluid is discharged therefrom with great force*, and the tendency is to spread the fuel rather in the form of a sheet to the combustion chamber."

No. 747,396 to Farnham (Ulen R. 347; and also in back of our main brief). This patent shows the chamber 1 for holding the material to be conveyed, the delivery pipe 6, and top and bottom pipes 7 for delivering compressed air into the tank 1, either above the material or into the delivery pipe 6, or into both at the same time. The velocity nozzle in this patent is marked 11. The patent states (p. 348):

"My invention relates to a sand-blast apparatus; and it has for its object to produce such an apparatus in which the sand will pass from the reservoir or tank by gravity alone or by gravity aided by compressed air within the reservoir under regulation, the sand passing from the tank through a delivery-pipe leading to a blast-pipe *provided with a blast nozzle or jet whose point of discharge is substantially beneath the discharge of the delivery-pipe into the blast-pipe*, so as to prevent any backflow of air from the sand-carrying pipe or hose into

> the delivery-pipe and at the same time *permitting the air-blast from the blast-nozzle to impact against the sand as it flows from the discharge-pipe, so as to drive it through the sand-carrying hose* to the point of its application."

The patent states further (pp. 348, 11, 89, *et seq.*) that the nozzle or jet 11 discharges compressed air into the delivery-pipe (exactly as is done in McMichael's commercial form), and states further at page 349:

> "At the same time the force of *the air blast from the nozzle* across the mouth of the discharge pipe strikes the sand as it issues from the mouth of the pipe and *propels it with velocity away from the pipe and through the carrying hose* and prevents any backflow or back-pressure from the hose or coupling and into the discharge pipe."

No. 758,118 to Sticker (Ulen R. p. 354). This patent states, at page 356, that by means of the velocity nozzle 30 a powerful impetus is given to the blast.

No. 837,113 to Phillips (Ulen R. p. 365). This patent shows almost exactly the arrangement of the patentee McMichael's commercial form. The patent states (p. 366):

> "The spout 13 when the conveyor is in operative position is arranged to discharge into a spout 22, which communicates with *a blast tube 23, having located therein a blast nozzle 24*, leading from a source of air supply (not shown). The end of the nozzle is located below and slightly in rear of the lower end of the spout 22, and *the blast therefrom is designed to direct the coal delivered from the said spout into a conducting pipe* 25."

Patent No. 837,622 to James (Ulen R. 368). This patent shows in Fig. 2 almost the exact structure of McMichael's commercial form. The patent states (p. 370):

> "A plurality of openings 26 are formed in the lower portion of the pipe 7, and are provided with closures 27, movable into and out of operative position, and these closures may be moved to permit the passage of matter from the conveyor into the chute, from which such matter will pass into the nozzle and *will be blown therefrom by the blasts from the pipe 21 and into the retort,* before which the nozzle is positioned."

The contention of the "velocity nozzle" was not raised in the lower courts, and the patents referred to are merely incidentally at hand, and many more could be produced on notice. The foregoing establish clearly that the "velocity nozzle" is an old and common expedient. In contending here that McMichael's invention is the "velocity nozzle," patentee in effect admits it has nothing other than what is old and common in the art.

Kolsche German Patent No. 18,394.

This patent shows a device practically identical with McMichael's, as so clearly pointed out by Judge BOURQUIN (R. 619, 620) as follows:

> "The third is Kolsche's German patent, 18,394 of 1882, for 'apparatus for conveying substances, slack, sandy, or granular material, by means of a current of air.' The apparatus is like McMichael's, without the U-bend; that is, it is an upright cylindrical container, with hopper bottom terminating in a discharge pipe. Compressed air is applied above or behind the material in the container, to force it down and into the discharge pipe, and at that point like air is admitted to assist in driving the material through the pipe.
>
> "Without any change, perhaps, save adjustments to circumstances as always, Kolsche's apparatus and method will transport concrete as does McMichael's. Kolsche could rightfully devote it to

> that analogous use. It follows that McMichael's essentially unchanged application of Kolsche to analogous materials and uses, is not invention. In principle, essential design, function, operation, object, and result, Kolsche and McMichael are one and the same. Either reads on the other. Kolsche, if later and devoted to concrete, might infringe McMichael, and by the same token, being earlier, he anticipates him."

A mere glance makes it clear that the only difference between Kolsche's and patentee's commercial device is in the diameter of the pipes. As to the relative size of pipes, the patent in suit states (p. 3, lines 120-122) (2d Cir. R. 286):

> "The engineer, in any instance, will readily understand what the relative proportions of the parts should be."

In the light of this teaching of the McMichael patent, his device and Kolsche's are patentably identical, as so clearly pointed out by Judge BOURQUIN.

In fact, "Petitioner's (*i. e.*, patentee's) *commercial* machine," as shown in the diagram facing page 76 of their brief, is like Kolsche and *is unlike the device of McMichael's patent*. The so-called "velocity nozzle" of patentee's commercial machine, like Kolsche's, points directly forwardly into the delivery pipe; while in McMichael's patent the so-called velocity nozzle is *within* the concrete containing chamber and merely discharges the air downwardly within the mass of concrete inside the chamber. Thus the patentee has abandoned the one novel feature of the patent in suit.

Respectfully submitted,

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